

## **REMARKS**

Applicant has studied the Office Action dated July 14, 2006 and has amended the claims. It is submitted that the application, as amended, is in condition for allowance. The Applicant has cancelled claims 8, 19 and 30, without prejudice and added new claims 35-37. By this amendment, claims 5-7, 9, 16-18, 20, 27-29, 31, and 34-37 are pending. Reconsideration and allowance of the pending claims in view of the following remarks is respectfully requested.

### **Rejection Under 35 U.S.C. § 112, First Paragraph**

The Examiner rejected claims 5, 16 and 27 under 35 U.S.C. § 112, first paragraph, as failing to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Office Action dated July 14, 2006, page 2, third paragraph. The Examiner states that "it is not clear to a person of ordinary skill in the art to discern how one would determine that the nonce value is valid and has been accepted for fewer than the limited number of requests." *Id.* The Applicant asserts that the specification adequately teaches a person of ordinary skill in the relevant arts how to make and use the invention and particularly how to realize this limitation without undue experimentation.

The Applicant points out that the specification teaches how to determine that the "received nonce value" is valid. Determining validity is taught by comparing the received nonce value to a list of valid token values. See, for example, specification, page 12, lines 6-9. Determining validity based on time expiration is also taught. Specification, page 12, lines 9-19.

With respect to determining if a nonce "has been accepted for fewer than the limited number of requests," the Applicant points out that the specification contains sufficient information to enable one skilled in the pertinent art to make and use the claimed invention without undue experimentation. MPEP §2164.01. The specification teaches determining if a nonce value is in a nonce database, and then removing that nonce value from the nonce database once it is accepted. Specification, page 12, lines 6-19.

This is a teaching of directly enabling determining if a nonce value has been accepted once. The Applicants assert that a person of ordinary skill in the computer programming arts would clearly be able to make the claimed invention, without undue experimentation, by understanding that determining if a nonce value has been accepted for fewer than the limited number of requests can be realized through the use of a simple counter. Using counters to determine if events have happened fewer than a specified number of times is well known to persons of ordinary skill in the computer programming arts.

The Applicant therefore asserts that the disclosure sufficiently teaches one of ordinary skill in the art how to make and use the present invention, and that the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

#### Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 5, 16 and 27 under 35 U.S.C. § 112, second paragraph, as being indefinite due to the use of the term "nonce." Office Action dated July 14, 2006, page 2, last paragraph. The Applicants have amended these claims to use the term "token value." Dependent claims have also been amended to provide proper antecedent basis for these amendments. Support for these amendments is found in the specification at, for example, page 5, lines 15-17. No new matter has been added by these amendments. The Applicants believe that these amendments have overcome the Examiner's rejection under 35 U.S.C. §112, second paragraph, and that this rejection should be withdrawn.

#### Rejection Under 35 U.S.C. § 101

The Examiner rejected claims 5, 16 and 27 under 35 U.S.C. § 101 by asserting that "the process of determining that the nonce value is valid and has been accepted for fewer than the specified number of request is not tangible or concrete since it is not clear how this process is carried out." Office Action dated July 14, 2006, page 5, penultimate paragraph. The Applicant traverses this rejection under 35 U.S.C. §101 and assert that the process as claimed, which accepts a request, performs defined processing, and includes providing a result as specified by "responding" to the request

by returning the data item in response to determining..." does provide a useful, tangible and concrete result. The Applicants assert that the result, i.e., "returning the data item," is a useful, concrete and tangible result. The Examiner cites a rejection based upon intervening processing used to determine if such a result is to be produced. Although the Examiner has raised a question of a proper teaching of the performance of this limitation, the Applicants assert that the utility of the specified process is clear to one of ordinary skill in the pertinent arts. See, MPEP, §2164.07.

The Applicant asserts that an asserted lack of clarity or enablement is more properly addressed by the Examiners rejection under 35 U.S.C. §112 for the same reason as stated for this rejection under 35 U.S.C. §101. The Applicant asserts that this rejection under 35 U.S.C. §101 is improper and should be withdrawn. For reasons discussed above, the Applicant further asserts that this process is adequately disclosed in the specification of the subject application.

#### Rejection Under 35 U.S.C. § 103, Serbinis and Eldridge

The Examiner rejected claims 5-9, 16-20 and 27-31 under 35 U.S.C. § 102(e) as being anticipated by *Serbinis et al.* (U.S. Patent No. 6,314,425) (hereinafter "Serbinis") in further view of *Eldridge et al.*, (U.S. Patent Publication No. 2002/0095570) (hereinafter "Eldridge"). The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole."

With respect to dependent claim 8, 19, and 30, the Applicants have cancelled those claims, without prejudice, thereby rendering the rejection of those claims moot.

With regards to independent claims 5, 16 and 27, the Applicant has amended these claims to more clearly describe "storing a list of valid token values" and "removing, in response to determining the received token value has been accepted for the specified number of requests, the received token value from the list of valid token values." Support for these amendments is found in the specification at, for example, page 10,

lines 8-9; page 11, lines 21-22; and page 12, lines 14-19. Dependent claims 8, 19 and 30 have been similarly amended to preserve antecedent basis. No new matter has been added by these amendments.

To begin, the Applicant asserts that modifying Serbinis with the teachings of the Eldridge reference is improper. The Serbinis reference identifies a problem of the prior art as failing to provide URLs comprising access tokens "that are not derived from user or resource information." Serbinis, column 2, lines 30-36. The Serbinis reference goes on to identify that an object of its invention is to provide a system "in which the access tokens are derived from random numbers independent of user or resource information, thereby providing for enhanced security of the internet-based document management system." Serbinis, col. 3, lines 50-56. The teachings of Eldridge, however, are completely incompatible with the objective of the Serbinis reference because the tokens of Eldridge include a specification of the storage location and filename of the resource (such as the document attachment to an e-mail). Eldridge, e.g., paragraph 0050. The Applicants assert that a person of ordinary skill in the art would not apply the teachings of Eldridge to modify the teachings of Serbinis because these two references are directed towards incompatible ends.

The Applicant further asserts that the cited references, taken either alone or in combination with one another, fail to teach the amended limitation of "removing, in response to determining the received token value has been accepted for the specified number of requests, the received token value from the list of valid token values." Therefore, the Applicants assert that amended independent claims 5, 16 and 27 distinguish over the cited references and that the rejection of these claims under 35 U.S.C. §103 should be withdrawn.

With regards to claims 9, 20 and 31, the Applicant traverses the Examiner's assertion that the combination of the Serbinis and Eldridge references teach that "the list of valid token values is shared with an entity that originated the data request." Office Action dated July 14, 2006, page 7, penultimate paragraph. The cited references, when taken either alone or in any combination with one another, do not teach or suggest sharing

files that contain any type of authorization or authentication information.” The Serbinis and Eldridge references only teach sharing files that are the actual resource requested by the user through the use of the token. Serbinis, Abstract, col. 2, lines 43-49; and Eldridge, paragraph 0082. Sharing the resource that is the object of protection by the Serbinis reference is clearly different from, and not a proper teaching of, the limitation recited by these dependent claims.

Additionally, the Applicant notes that dependent claims 6-7, and 9; 17-18, and 20; and 28-29 and 31, depend from independent claims 5, 16, and 27, respectively. As discussed above, amended independent claims 5, 16 and 27 distinguish over the cited references. Since dependent claims include all of the limitations of the independent claims from which they depend, Applicant further asserts that amended dependent claims 6-9, 17-20 and 28-31 also distinguish over the cited references as well. Therefore, the Applicant respectfully asserts that the Examiner’s rejection under 35 U.S.C. §103(a) should be withdrawn.

#### Rejection Under 35 U.S.C. § 103, Serbinis and Khater or Pinarsky

The Examiner rejected claim 34 under 35 U.S.C. § 103(a) as being anticipated by *Serbinis et al.* (U.S. Patent No. 6,314,425) (hereinafter “Serbinis”) in further view of *Khater*, (U.S. Patent Publication No. 2002/0184143) (hereinafter “Khater”) or Pinarsky (U.S. Patent Publication No. 2002/0147838) (hereinafter “Pinarsky”).

The Applicant notes that dependent claim 34 depends from independent claims 5. As discussed above, amended independent claim 5 distinguishes over the cited references. Since dependent claims include all of the limitations of the independent claims from which they depend, Applicant further asserts that dependent claim 34 also distinguishes over the cited reference as well. Therefore, the Applicant respectfully asserts that the Examiner’s rejection under 35 U.S.C. §103(a) over Serbinis and Khater or Pinarsky should be withdrawn.

#### New Claims

The Applicant has added new claim 35-37. Support for new claim 35 is found in the

specification at, for example, page 9, lines 13-25. Support for new claim 36 is found in the specification at, for example, page 11, lines 15-30. Support for new claim 37 is found in the specification at, for example, page 14, lines 18-30 and page 16, lines 7-16.

No new matter has been added by these amendments. The Applicant asserts that the limitations of these new claims are not taught or suggested by the cited references taken either alone or in any combination.

### **CONCLUSION**

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

Applicant acknowledges the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorney.

Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

**PLEASE CALL** the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

Date: November 14, 2006

By: 

Jeffrey N. Giunta, Reg. No. 42,583  
Attorney for Applicant  
FLEIT, KAIN, GIBBONS, GUTMAN  
BONGINI & BIANCO P.L.  
Tel (561) 989-9811  
Fax (561) 989-9812